REMARKS

Specification Objections

Relevant portions of the specification have been amended to address Examiner's concerns regarding the use of trademarks in a patent application. Applicant notes that all trademarks were already accompanied by their generic terms, e.g. the use of WINDOWS in [0013], when read in context, is already in a portion which is discussing types of operating systems. However, Applicant has made some amendments to make the generic terms more explicit.

Claim Rejections 35 U.S.C. § 102

Claims 1-6, 8, 10-12, 14-20, 23-26, and 28-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by O'Shea (U.S. Application 2004/0128568).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

In the previous response, Applicant argued that in O'Shea, the operating system does not decide whether to grant the request for a change in control, that O'Shea does not discuss having the operating system make any decision, etc. Examiner responds by stating that the decision in O'Shea is made based on whether "further execution of the code of the operating system" is taking place. This however only shows that the decision is made based on whether the operating system is executing code. It does not show that the operating system is making the decision.

The very first lines of O'Shea make clear that the power management control functionality of the computer system is used to usurp control. (See O'Shea [0001] lines 1-3). Power management controls generally work outside of the operating system software and are provided by hardware manufacturers. Hence, as shown above, the power management controls monitor the computer system to determine whether an operating system is executing code, and interrupt decisions are made in response to the monitoring (as shown in steps 350/351 of O'Shea). Thus, in O'Shea, the operating system does not make the usurping decision relating to handing over control of the processor.

To further illustrate Applicant's point that O'Shea does not use the OS in decision making, it is noted that there is a large technical difference between "usurping" control in O'Shea, and "borrowing" control of the processor as discussed in the present invention. Operating systems will consider usurped processors to have failed in the event that the OS attempts to use the processor after it has been usurped. As a result, if the processor comes back on line after being usurped, an OS will be confused. Conversely, where an OS makes the decision to allow a processor to be "borrowed", the confusion is eliminated. It is clear that the techniques employed in the O'Shea reference usurp control of the computer system when the OS is not executing code (see abstract; [0014]), as opposed to the present invention which allows for borrowing the processor with permission of the OS.

Hence, applicant respectfully submits that the arguments made in the previous response are correct and that the present invention is in condition for allowance. In the event that it would be helpful to discuss the above noted fundamental differences between O'Shea and the present invention, Examiner is strongly encouraged to call the undersigned who will be pleased to assist in any manner possible.

For the sake of completeness of the present response the previously submitted arguments are repeated below. Applicant respectfully submits that these arguments are correct and properly show why the present rejections are improper.

Claim 1 defines a method for changing control of a processor that is in an active state under the control of an operating system to a borrowed state wherein the processor is under control of firmware. The method includes deciding, by the operating system, whether to grant the request. O'Shea does not disclose at least these limitations. The Office Action relies on paragraph [0043], lines 1-19 of O'Shea as teaching these limitations. However, this portion of O'Shea does not discuss having the operating system decide whether to grant the request for a change in control. This paragraph allows for code to be executed by the operating system before entry into the lower power state if the code exists. Thus, this paragraph does not discuss having the operating system make any decision. Thus, O'Shea does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 15 defines a computer system wherein the operating system decides whether to place the processor in the borrowed state and sends an interrupt signal to move the processor into the borrowed state. O'Shea does not disclose at least these limitations. The Office Action relies on paragraph [0043], lines 1-19 of O'Shea as teaching these limitations. However, this portion of O'Shea does not discuss having the operating system decide whether to place the processor in the borrowed state. This paragraph allows for code to be executed by the operating system before entry into the lower power state if the code exists. Thus, this paragraph does not discuss having the operating system make any decision. Thus, O'Shea does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 15 is patentable over the 35 U.S.C. § 102 rejection of record

Claim 31 defines a computer system that has a processor for executing code, and includes means, operative by the operating system, for deciding whether to grant the request. The Office Action relies on paragraph [0043], lines 1-19 of O'Shea as teaching these limitations. However, this portion of O'Shea does not discuss having a means that is operable by the operating system for deciding whether to grant the request to change control. This paragraph allows for code to be executed by the operating system before entry into the lower power state if the code exists.

Thus, this paragraph does not discuss having the any means operable by the operating system to make any decision. Thus, O'Shea does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 31 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 33 defines a computer readable medium having computer program logic recorded thereon for changing control of a processor that is in an active state under the control of an operating system to a borrowed state wherein the processor is under control of firmware. The medium includes logic for deciding, by the operating system, whether to grant the request. The Office Action relies on paragraph [0043], lines 1-19 of O'Shea as teaching these limitations. However, this portion of O'Shea does not discuss having logic for deciding, by the operating system, whether to grant the request for a change in control. This paragraph allows for code to be executed by the operating system before entry into the lower power state if the code exists. Thus, this paragraph does not discuss having any logic for deciding by the operating system to make any decision. Thus, O'Shea does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 33 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-6, 8, 10-12, 14, 16-20, 23-26, 28-30, 32, and 34 depend from base claims 1, 15, 31, 33, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-6, 8, 10-12, 14, 16-20, 23-26, 28-30, 32, and 34 sets forth features and limitations not recited by O'Shea. Thus, the Applicant respectfully asserts that for the above reasons claims 2-6, 8, 10-12, 14, 16-20, 23-26, 28-30, 32, and 34 are patentable over the 35 U.S.C. § 102 rejection of record.

Rejections Under 35 U.S.C § 103

Claims 7, 9, 21, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Shea in view of the article entitled "Advanced Configuration and Power Interface Specification", revision 2.0b, dated 11 October 2002, (hereinafter the ACPI specification).

Claims 13 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Shea in view of the article entitled "Itanium Processor Family System Abstraction Layer Specification", Intel document number 245359-005, July 2001 (hereinafter the SAL specification).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

The Office Action admits that O'Shea does not teach having various limitations as described on pages 12 -16 of the Office Action. The Office Action attempts to cure this deficiency by introducing the ACPI specification and the SAL specification, which the Office Action alleges to teach having such elements. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claims 1 and 15 are defined as described above. O'Shea does not disclose these limitations, as discussed above. Neither the ACPI specification nor the SAL specification are relied upon in the Office Action as disclosing these limitations. Therefore, the combinations of O'Shea with the ACPI specification and the SAL specification do not teach all elements of the claimed invention.

Claims 7, 9, 21-22, 13, and 27 depend from base claims 1 and 15, respectively, and thus inherit all limitations of their respective base claim. Each of claims 7, 9, 21-22, 13, and 27 sets forth features and limitations not recited by the combinations of O'Shea with the ACPI specification and the SAL specification. Thus, the Applicant respectfully asserts that for the above reasons claims 7, 9, 21-22, 13, and 27 are patentable over the 35 U.S.C. § 103(a) rejections of record.

Conclusion

In view of the above, applicant believes the pending application is in condition for allowance, and respectfully requests favorable reconsideration.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 100203448-2 from which the undersigned is authorized to draw.

Dated: November 27, 2007

Respectfully submitted,

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: November 27, 2007

Signature: Joy H. Perigo
Joy H. Perigo